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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,688	06/13/2001	Annemarie Poustka	POUSTKA-2	6614
20151 7590 02/07/2008 HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			EXAMINER EPPERSON, JON D	
			ART UNIT 1639	PAPER NUMBER
			MAIL DATE 02/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/880,688

Applicant(s)

POUSTKA ET AL.

Examiner

Jon D. Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54,56-60,66-71,75 and 77-86 is/are pending in the application.
- 4a) Of the above claim(s) 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54,56-60,66-71,75,77-84, 86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. The Response filed November 27, 2007 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Status of the Claims

3. Claims 54, 56-60, 66-71, 75, 77-86 were pending. Applicants amended claims 57, 60, 67, 75, 78, 80, 83, and 85. No claims were added or canceled. Therefore, claims 54, 56-60, 66-71, 75, 77-86 are currently pending. Claim 85 is drawn to non-elected species and/or inventions and thus this claims remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), there being no allowable generic claim. Therefore, claims 54, 56-60, 66-71, 75, 77-84, and 86 are examined on the merits.

Withdrawn Objections/Rejections

4. The new matter rejection denoted "A" under 35 U.S.C. § 112, first paragraph is withdrawn in view of Applicants' amendments changing the term "suitable" to "solid." The rejection under 35 U.S.C. § 112, second paragraph denoted "A2" is withdrawn in view of Applicants' amendments to claims 57 and 78 changing "the range" to "a range." The rejection under 35 U.S.C. § 112, second paragraph rejection denoted "C2" is withdrawn in view of Applicants' amendment to claim 67. The 35 U.S.C. § 112, second paragraph rejection denoted

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“E2” is withdrawn in view of Applicants’ amendments thereto adding steps (a)-(c) to the “repeating” phrase. All other rejections are maintained and the arguments are addressed below.

Outstanding Objections and/or Rejections

Claim Rejections - 35 USC § 112, second paragraph

5. Claims 54, 56-60, 66-71, 75, 77-84, and 86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A1. Withdrawn.

B1. Withdrawn.

C1. Withdrawn.

D1. **Claim 83** recites the limitation “the monomers” in lines 6 and 7. There is insufficient antecedent basis for this limitation in the claim. In addition, the term “reversibly immobilized monomers” in line 8 lacks an indefinite/definite article and, as a result, it is unclear whether a specific monomer or, alternatively, any monomer within this general class is being referred to. Therefore, claim 83 and all dependent claims are rejected under 35 USC 112, second paragraph.

A2. Withdrawn.

B2. **Claim 60** recites, “the linking reaction” in line 3. There is insufficient antecedent basis for this limitation in the claim. For example, it is unclear to which “linking reaction” Applicants are referring to (e.g., linking to substrate, linking to first layer, linking to second layer, etc.). In addition, the phrase “until start” now lacks a definite or

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indefinite article before the word start. Therefore, claim 60 and all dependent claims are rejected under 35 USC 112, second paragraph.

C2. Withdrawn.

D2. **Claims 75, 80, 83, and 85** recite, "by covalent linking" in the second to last line of each claim. First, the term "covalent linking" is missing a definite or indefinite article. Thus, it is unclear whether a specific covalent linking is being referred to or, alternatively, a general class of covalently linking. Furthermore, to the extent that a specific covalent linking is being referred to (i.e., as in the phrase "the covalent linking"), there is insufficient antecedent basis for this limitation in the claim. Therefore, claim 75, 80, 83, and 85 and all dependent claims are rejected under 35 USC 112, second paragraph.

E2. Withdrawn.

Response

D1. Applicants argue, "claim 83 was amended to add numerals for the steps and to delete 'the'." (e.g., see 11/27/07 Response, page 10).

This is not found persuasive for the following reasons:

The amendment does not cover the term "the monomers" set forth in lines 6 and 7. Thus, the rejection is still applicable. Furthermore, deletion of the word "the" in line 9 amounts to little more than form over substance. The fact remains that the reversibly immobilized monomers was not previously introduced in the claim. Furthermore, the phrase "by reversibly immobilized monomers" lacks either a definite or indefinite article

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and thus it is unclear as to whether Applicants are referring to a particular immobilized monomer or any immobilized monomer that belongs to that class.

B2. Applicants argue, “there is only one type of linking reaction as set forth in the claim. The claim is clear on this” (e.g., see 11/27/07 response, page 10, last paragraph).

This is not found persuasive for the following reasons:

The Examiner respectfully disagrees. As noted in the above rejection, the claim could be referring to many different reactions including linking to substrate, linking to first layer, linking to second layer, etc. Applicants never state in their response which reaction is being referred to, nor do they state it in the claims. In addition, removing the word “the” before the word start seems to be completely unrelated to the rejection and thus only further serves to confuse an already indefinite claim.

D2. Applicants amended the claim to remove the word “the” in the phrase “the covalent linking” in the second to last line.

This is not found persuasive for the following reasons:

It is respectfully submitted that this amendment or serves to further confuse a claim that is already indefinite by addition the additional issue of having to guess what article (i.e., definite or indefinite) should have been placed in front of the word covalent. Thus, the claim remains unclear.

Accordingly, the 35 U.S.C. 112, second paragraph rejections cited above are maintained.

Claim Rejections - 35 USC § 112, first paragraph

6. Claims 54, 56-60, 66, 68-71, 75, 77-84, and 86 are rejected under 35 U.S.C. 112, first

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paragraph, as based on a disclosure that is not enabling. The object of administration (e.g., a host) is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). For example, Applicants state that both the laser printer and color laser printer require “magnetic particles” for successful operation (e.g., see specification, pages 28 and 29; see also figures 8 and 9; see also paragraphs 26 and 27 on page 8; see also paragraphs 37 and 38 on page 11; see also paragraphs 42-45 on page 12; see also paragraphs 54 and 55 on page 14; see also paragraphs 56 and 57 on page 16; see also paragraphs 95 and 96 on page 28; see also paragraphs 96 and 96 on page 28; see also page 29; see also top of page 30; see also paragraph 101 on page 31; see also paragraph 107 on page 33; see also paragraph 115 on page 34; see also page 36, paragraphs 123-125). That is, they wouldn’t bind to the magnetic roller (e.g., element 21 in figures 8 and 9) without them. Also, the particles must possess triboelectric properties because they wouldn’t become charged upon contact to the roller without it. Thus, the magnetic/triboelectric particles are critical and/or essential to the practice of the currently claimed invention that uses “laser” printing (e.g., see newly amended independent claims 75, 80, and 83 adding the “laser” limitation; note also that dependent claim 67 was not rejected because it claims the essential “magnetic” particles). Applicants can overcome this rejection by adding “magnetic” particles to the independent claims similar to that set forth in claim 67.

In addition, the Examiner notes that it would take undue experimentation to practice the claimed invention without magnetic/triboelectric particles. Factors to be considered may include: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of

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the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. In *re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404.

Here, Applicants admit (e.g., see citations above) that such particles would not bind to the roller and/or would not acquire the requisite charge for laser printing. In addition, Applicants provide no guidance for how to operate a laser printer without the use of particles with magnetic/tirobelectric properties.

Response

7. Applicant's arguments directed to the above Enablement rejection were fully considered (and are incorporated in their entirety herein by reference) but were not deemed persuasive for the following reasons. Please note that the above rejection might have been modified from its original version to more clearly address applicants' newly amended and/or added claims and/or arguments.

[1] Applicants argue that they cannot be held to just their examples noting that on page 11 of the specification Applicants refer to the "magnetic" embodiment as a best mode (e.g., see 11/27/07 Response, bottom of page 11).

This is not found persuasive for the following reasons:

[1] The Examiner respectfully disagrees. What Applicants refer to as a "best mode" or "preferred embodiment" is actually the "only" mode supported by the specification. See *In re Mayhew*, 188 USPQ 356, 357 (CCPA 1976) (wherein Applicants also described essential subject matter as their "best mode" in an unsuccessful attempt to overcome an enablement rejection). Here, Applicants provide no other means for transferring the toner particles to the magnetic

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roller (e.g., see paragraphs 96 and 97 describing mechanism for laser printers). In addition, the particles will not gain the essential electrostatic charge for the jump to the laser-writable roller if they cannot reach the magnetic rollers in the first place (e.g., see paragraph 97). This position is consistent with Applicants' specification that describes in every "laser" example the use of some kind of magnetic particles that have either been attached or incorporated into the toner particles (e.g., see paragraph 57, Another characteristic of said monomer-toner particles is that they contain magnetic constituents or bind to particles which contain magnetic constituents" see also passages cited in rejection). Thus, the use of magnetic particles is essential to the claimed "laser" embodiments (e.g., see claim 67 that was not rejected under 35 U.S.C. § 112, first paragraph because the essential magnetic constituents are claimed therein).

[2] Applicants argue, "it is well established that the specification is not required to teach every detail of the invention ... It is only necessary to draft the specification in such a manner that a person skilled in the art is able to make and use the invention, without requiring inordinate amount of experimentation" and cite *In re Geerdes* in support of this position (e.g., see 11/27/07 Response, pages 11 and 12).

[2] The Federal Circuit has cautioned against over reliance on the assertion that everything needed to practice the full scope of the claims was "known in the art" and that a patent need not teach, and preferably omits, what is well known in the art. See *Genentech Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997): "[T]hat general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. ... It is the specification, not the knowledge of one

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skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement.” Here, the specification only teaches how to transfer magnetic particles using a laser. Applicants point to nothing in the specification that would indicate to the contrary (i.e., the use of non-magnetic particles in conjunction with the laser).

[3] Applicants argue, “a person skilled in the art at or prior to 1998 knew or was knowledgeable about one component toners and would be able to make and use the invention, even though the specification lacks a working example” (e.g., see 11/27/07 Response, page 12).

[3] Applicant’s arguments do not rise to the level of factual evidence. See MPEP § 716.01(c): The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Here, Applicants cite no reference to support this conclusion. In addition, Applicants don’t state that magnetic particles are not used in conjunction with the one-component toners. Thus, even if, for the sake of argument, we assume that Applicants’ unsubstantiated statements are true, it would not change the result.

Accordingly, the Enablement rejection cited above is hereby maintained.

Conclusion

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this

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final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jon D. Epperson/
Primary Examiner, AU 1639